



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,059	07/09/2003	Shane Atwell	022132-000510US	2646

20350 7590 01/13/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

VOGEL, NANCY S

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,059	Applicant(s) ATWELL ET AL.	
	Examiner Nancy T. Vogel	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-50 are pending in the case.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is based on the Guidelines for the Examination of Patent Applications under the 35 U.S.C. 112, first paragraph "Written Description published in the Federal Register (Volume 66, Number 4, Pages 1099-1111). Claims 1, 20, and 36 are drawn to a method of increasing soluble protein expressed in a host cell, comprising co-expressing said protein with a phosphatase. Dependent claims recite various protein types, cell types, vector types and phosphatase types. Claims 1-50 are genus claims in terms of a method of increasing production of any protein, by co-expressing said protein with any phosphatase, using any cell type and any vector as a host. The disclosure is not deemed to be descriptive of the complete structure of a representative number of species encompassed by the claims as one of skill in the art cannot envision all the

Art Unit: 1636

methods utilizing the encompassed polypeptides and cells based on the teachings of the specification. While the specification provides general information on increasing soluble amounts of certain proteins with certain phosphatase in certain cells, there is no disclosure of the precise identity or shared structures of polypeptides and/or phosphatases which, when co-expressed would result in the recited increased amount, ie. . there is no structure/function analysis of said proteins or phosphatases which would provide evidence that applicants possessed the invention as claimed. Therefore, the specification does not describe the claimed method utilizing peptides substantially similar to at least a portion of any oomycete FtsZ-mt in such full, clear, concise and exact terms so as to indicate that Applicant has possession of the method at the time of filing the present application. Thus, the written description requirement has not been satisfied.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 14-17, 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 14-17 recite the limitation "said expression vector" in line 1. There is insufficient antecedent basis for this limitation in the claim on which the claims are dependent, ie claim 10.

Claims 21-29 recites the limitation "the protein or peptide is...", "wherein the host cell is...", "wherein the phosphatase is encoded in..." wherein an expression vector is use...", wherein said phosphatase and said protein or peptide..." in line 1 or line 1-2. There is insufficient antecedent basis for this limitation in the claim on which the claims are dependent, i.e. claim 19.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 11, 12, 14, 36, 44, 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Strovel et al. (Exper. Cell Res., 253:637-648, 1999).

Strovel et al. disclose a method comprising co-expressing a protein which is heterologous to the cell, and a phosphatase (see abstract, see page 639-640). It is considered that more soluble protein is obtained when said protein is co-expressed with the phosphatase than without said phosphatase, since it is disclosed in the instant application that this would be an inherent result. The two proteins are encoded by genes present on expression vectors on plasmids.

Claims 1-4, 7-9, 11-14, 36, 38, 41-42, 44-45 are rejected under 35 U.S.C. 102(a) as being anticipated by Kholod et al., (Biotechniques, Vol. 31, 2, pp: 322-328, 2001.

Kholod et al. disclose a method comprising co-expressing in E. coli, a protein which is heterologous to the cell, which is a kinase, and a phosphatase. It is considered that more soluble protein is obtained when said protein is co-expressed with the phosphatase than without said phosphatase, since it is disclosed in the instant application that this would be an inherent result. The two proteins are encoded by genes present on expression vectors on plasmids.

Double Patenting

Applicant is advised that should claim 4 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

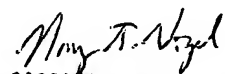
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy T. Vogel whose telephone number is (571) 272-0780. The examiner can normally be reached on 6:30 - 3:00, Monday - Friday.

Art Unit: 1636

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NANCY VOGEL, Ph.D.
PATENT EXAMINER

Ntv
12/23/05